

Remarks

Claims 21 – 46 remain in the application, and claims 47 and 48 have been added. Applicant includes herewith a terminal disclaimer and a completed credit card payment form PTO-2038 for 215 dollars to cover the 65 dollar cost of the terminal disclaimer and to cover the 100 dollar cost of one more additional independent claim beyond three independent claims and the 50 dollar cost of two more additional claims beyond twenty claims. This transmittal is presented in response to the third office action and is believed to completely resolve each issue as raised by the examiner. Applicant believes the claims as amended to be non-obvious and patentably distinct from all prior art.

OA Item #1: Rejection of claims 21-46 under 35 USC § 112 Indefiniteness:

Applicant respectfully traverses the examiner's rejection of claims 22, 28, and 46 under 35 USC § 112 with respect to the definition of the group of work piece categories. Although Applicant agrees that the examiner has identified non-mutually exclusive work pieces falling within the various work piece group categories, contrariwise Applicant can also identify a mutually exclusive work piece falling within each claimed work piece category. For instance, a "colorable work piece" could be a cube shaped wooden block. A "substantially egg shaped work piece" could be a porous ceramic egg shaped work piece. An "edible work piece" could be a spherically shaped candy work piece. And an "egg" could be for instance a real chicken egg. Thus, in contrast to the example presented by the examiner, Applicant has clearly shown that each claimed group category defines a mutually exclusive work piece. Accordingly, Applicant respectfully requests that the examiner's rejection of claims 22, 28, and 46 be withdrawn.

In response to the examiner's rejection of claims 22, 40, and 46 under 35 USC § 112 with respect to the definition colorant, by deleting the term "a colorant pill", Applicant has modified claims 22, 40, and 46 to define mutually exclusive colorants. Accordingly, Applicant respectfully requests that the examiner's rejection of claims 20, 40, and 46 be withdrawn.

In regards to the examiner's rejection of claims 21, 28, 34, 40, and 46 under 35 USC § 112 with respect to the definition of a container, Applicant respectfully suggests that there is no inference to more than one container. Applicant suggests that the claim language "said container defines a

container” merely provides greater definition and limitations to the container and does not infer a plurality of containers. Applicant suggests that such claim language would be analogous to claiming “A pencil defining a red pencil having an eraser on a first end of said pencil”. In the sample pencil claim, there is no implication of a plurality of pencils, rather the claim merely limits the pencil to a pencil of a special category, i.e. the category of red pencils having an eraser on a first end of the pencil. Likewise, Applicant suggests that Applicant’s container claim language is not confusing, but rather merely defines and limits the category of container. Nevertheless, to avoid confusion suggested by the examiner, Applicant has modified claims 21, 28, 34, 40, and 46 to replace the words “defines a container having” with the word “includes”. Accordingly, Applicant respectfully requests that the examiner’s rejection of claims 21, 28, 34, 40, and 46 be withdrawn.

OA Item #2: Rejection of claims 21-45, 27-31, 33-37, 39-43, and 45 under Obvious Type Double Patenting:

In response to the examiners double patenting rejection, Applicant files herewith a terminal disclaimer. Accordingly, Applicant respectfully requests that the double patenting rejection be withdrawn.

OA Item #3: Question of inventorship and ownership:

The examiner states that, “This application currently names joint inventors”. Applicant respectfully draws to the examiner that the application does not name joint inventors. Applicant points out that Applicant is the sole inventor of the subject invention. Applicant also points out that Applicant is the sole inventor of all patent applications and now issued patents that form the basis from which this application is a continuation in part. Further, Applicant avers that Applicant is the sole owner of the aforementioned patent applications and patents.

OA Item #4: Rejection of claims 40, 42, and 45 under 35 USC § 102(b) over Hunter:

In response to the examiner’s rejection of claims 40, 42, and 45, in claim 40, Applicant has replaced the word “colorant” with the word “dye”. Applicant notes that dye and the process of dying

are distinct from the paint as taught by Hunter. As taught in Applicant's application (see for instance Applicant's specification, "Summary of the Invention", page 3), the process of dying includes the use of a dye typically in a concentrated form and typically mixed with water and a work piece such as an egg brought in contact with the dye typically for some extended period of time. This process causes the exposed workpiece surfaces to take on the color of the dye or become "dyed". However, the dyed surfaces are not "coated" with a colorant as is the case in the process of painting. In Applicant's specification, the process of dying and the process of painting are held to be distinct and Applicant suggests a different shaped container for painting as opposed to dying. Hunter did not teach dye or dying and as such, Applicant respectfully suggests that Applicant's application now defines over Hunter. Accordingly, Applicant respectfully requests that the examiner's rejection be withdrawn.

OA Item #5: Rejection of claims 28-31, 33-37, 39, 41, and 43 under 35 USC § 103(a) over Hunter:

Applicant respectfully traverses the examiner's rejection of claims 28-31, 33-37, 39, 41, and 43. Applicant respectfully points out that the teaching of Hunter is far removed from that of the Applicant. With respect to claims 28 and 34, Applicant notes that the contained matter that is prevented from spilling, the utensil, and the work piece are all distinct entities. Applicant points out that it is the function of the utensil to manipulate the work piece, especially while the work piece is in the container. While it is readily acknowledged that Hunter suggests that his container may be used to contain "granular material" or "small parts", Hunter as clearly points out that such suggested contents are in place of the normal water or paint (see page 3 lines 68 & 69 – "It is considered that materials other than water and paint could be used"), and that such contents are to be the contents of the container that are kept from spilling (see page 3 line 70 – "granular material", and page 4 lines 1-3 – "containing small parts for an assembly line where the container could be accidentally upset"). Thus the suggested alternative contents of Hunter are merely flowable and otherwise spillable contents that are not to be confused with those items that are used to perform work within the container. Applicant notes that in Applicant's preferred embodiment, neither the work piece nor the utensil is kept from spilling (see for instance figure 3 as compared to figure 4 of Applicant's application). Specifically, in Applicant's preferred embodiment, Applicant's container is designed such that upon inverting the container, the

flowable contents will be kept from spilling but the work piece will roll out of the container. With respect to the examiner's assertion that Hunter teaches that Hunter's container, "may contain paint in combination with an applicator (a paint brush)" (see page 7, line 17 of the office action), Applicant finds no such teaching by Hunter. Furthermore, just as any teaching or suggestion placing a work piece in the container is absent from Hunter, likewise, any teaching or suggestion that a utensil, let alone a utensil falling within the scope of claim 28, is also absent from Hunter.

With respect to claims 29-31, 33, 35-37, 39, 41, and 43, Applicant respectfully points out that each of these claims are dependant upon an independent claim and as such each of these claims inherently include all of the limitations of the respective claim upon which they depend. Thus such dependent claims are not seen as broadening the scope of claim coverage but rather as narrowing the scope of coverage. In determining patentability of these currently rejected dependant claims, Applicant respectfully points out that the examiner must also give consideration to each of the limitations in each of the respective independent claims from which these dependant claims depend. Accordingly, even though such claims may or may not be separately rejected under 35 USC § 103(a) due to limitations such as the container being made from formed plastic "sheet" or the container being transparent, etc., because each dependant claim is also examined in light of the claim from which it depends, Applicant believes the claims to be non-obvious.

Based on the arguments provided above, Applicant respectfully suggests that claims 28-31, 33-37, 39, 41, and 43 define over Hunter and that claims 28-31, 33-37, 39, 41, and 43 are non-obvious.

OA Item #6: Rejection of claims 29, 35, and 41 under 35 USC § 103(a) over Hunter in view of Lintvedt:

In response to the examiners rejection of claims 29, 35, and 41, Applicant respectfully points out that each of the claims are dependant upon an independent claim and as such each of these claims inherently include all of the limitations of the respective claim upon which they depend. Further, as noted above, each of the relied upon independent claims has been modified and is believed to be patentably distinct and allowable. Thus such dependent claims are not seen as broadening the scope of claim coverage but rather as narrowing the scope of coverage. In determining patentability of these

currently rejected dependant claims, Applicant respectfully points out that the examiner must also give consideration to each of the limitations in each of the respective independent claims from which these dependant claims depend. Accordingly, even though such claims may or may not be separately rejected under 35 USC § 103(a) due to limitations such as the container being made from formed plastic “sheet” or the container being transparent, etc., because each dependant claim is also examined in light of the claim from which it depends, Applicant believes the claims to be non-obvious. Examined in this light, Applicant respectfully suggests that the Examiner will conclude that the currently rejected claims define over Hunter and Lintvedt. Accordingly, Applicant respectfully requests that the examiner withdraw the rejection.

OA Item #7: Rejection of claims 28, 30, 33, 40, 42, and 45 under 35 USC § 102(b) over Japan ‘388:

In response to the examiner’s rejection of claims 28, 30, 33, 40, 42, and 45, in claim 28, Applicant has added the term “non-utensil”, and in claim 40, Applicant has replaced the word “colorant” with the word “dye”. Applicant notes that inasmuch as claim 28 now specifically defines the work piece as a non-utensil work piece (e.g. not a brush or straw or dipper or tongs, etc.), Applicant respectfully suggests that claim 28 defines over Japan ‘388. Applicant also notes that dye and the process of dying are distinct from the paint and ink as taught by Japan ‘388. As taught in Applicant’s application (see for instance Applicant’s specification, “Summary of the Invention”, page 3), the process of dying includes the use of a dye typically in a concentrated form and typically mixed with water and a work piece such as an egg brought in contact with the dye typically for some extended period of time. This process causes the exposed work piece surfaces to take on the color of the dye or become “dyed”. However, the dyed surfaces are not “coated” with a colorant as the case in the process of painting. In Applicant’s specification, the process of dying and the process of painting are held to be distinct and Applicant suggests a different shaped container for painting as opposed to dying. Japan ‘388 did not teach dye or dying and as such, Applicant respectfully suggests that Applicant’s application now defines over Japan ‘388.

With respect to claims 30, 33, 42, and 45, Applicant respectfully points out that each of these claims are dependant upon an independent claim and as such each of these claims inherently include all of the limitations of the respective claim upon which they depend. Thus such dependent claims are not seen as broadening the scope of claim coverage but rather as narrowing the scope of coverage. In determining patentability of these currently rejected dependant claims, Applicant respectfully points out that the examiner must also give consideration to each of the limitations in each of the respective independent claims from which these dependant claims depend. Accordingly, even though such claims may or may not be separately rejected under 35 USC § 103(a) due to limitations such resistance to spillage of non-gaseous liquids or container assembly method, etc., because each dependant claim is also examined in light of the claim from which it depends, Applicant believes the claims to be non-obvious.

Based on the arguments provided above, Applicant respectfully suggests that claims 30, 33, 42, and 45 define over Japan '388.

OA Item #8: Rejection of claims 29, 31, 41, and 43 under 35 USC § 103(a) over Japan '388:

Applicant respectfully traverses the examiner's rejection of claims 29, 31, 41, and 45. Applicant respectfully points out that the listed claims are dependent having all of the respective limitations of the claims from which they depend. Applicant traverses the examiner's rejection for the same reason relating to dependant claims as provided in items 5, 6, and 7. Accordingly, Applicant respectfully requests that the examiner withdraw the rejection.

OA Item #9: Rejection of claims 29 and 41 under 35 USC § 103(a) over Japan '388 in view of Lintvedt:

Applicant respectfully traverses the examiner's rejection of claims 29 and 41. Applicant respectfully points out that the listed claims are dependent having all of the respective limitations of the claims from which they depend. Applicant traverses the examiner's rejection for the same reason relating to dependant claims as provided in items 5, 6, and 7. Accordingly, Applicant respectfully requests that the examiner withdraw the rejection.

Conclusion:

Applicant notes that any amendments made by this paper which are not specifically discussed herein are made solely for the purpose of more clearly and particularly pointing out and claiming Applicant's invention.

Applicant specifically reserves the right to prosecute claims of broader and differing scope than those presented herein in a continuation application.

Applicant submits that the amendments to the claims and the arguments presented herein have placed the claims in condition for allowance. Action in accordance therewith is earnestly solicited.

If the Examiner has any questions or comments which may be resolved over the telephone, she is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: January 24, 2005

Respectfully submitted,

A handwritten signature in cursive script, reading "Michael R. Schramm". The signature is written in black ink and is positioned above a horizontal line.

Michael R. Schramm